Customer No. 27061   Patent
                                            Attorney Docket No. GEMS8081.107

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Trevino et al.	**RECEIVED** **CENTRAL FAX CENTER**
Serial No.	:	09/683,130	**OCT 07 2005**
Filed	:	November 21, 2001	
For	:	Method and Apparatus for Prescribing an Imaging Scan and Determining User Input Validity	
Group Art No.	:	2621	
Examiner	:	Lavin, C.	

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Dear Sir:

A Notice of Appeal is filed concurrently herewith. A petition for Extension of Time has been filed under separate cover. Applicant hereby requests pre-appeal review of the final rejection in the above-identified application. No amendments are being filed with this request. The review is requested for the reasons set forth below.

REMARKS

Claims 1–9, 11, and 13-31 are currently pending in the present application. In the Advisory Action of August 11, 2005, the Examiner maintained the rejection of claims 9-18 under 35 U.S.C. 102(e) as being anticipated by Wu et al. (hereinafter Wu), the rejection of claims 1-8, and 19-24 under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Gaertner, and the rejection of claims 25-31 under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Seybold and Gaertner.

In the Advisory Action mailed, August 25, 2005, the Examiner stated that "applicant's primary argument revolves around the word 'may'." The Examiner further interpreted "may" as optional language and construed "may" to read "may or may not." The Examiner's interpreting of the term "may" as optional language and construing of the term "may" to read "may or may not" is improper. That is, the term "may" is not conditional. There is no basis for interpreting "may" as optional language or for construing "may" to read "may or may not" as called for in claim 9.

"May" is defined as "to be allowed or permitted to." *See Amendment/Response To Advisory Action, October 7, 2005.* This definition does not define "may" as "to be allowed or permitted to or not to be allowed or permitted to" as the Examiner has construed the term. The Examiner's construing of the term "may" to read "may or may not" construes claim 9 to read, for example, that a change to one of the set of tertiary scan parameters <u>is allowed to or is not allowed to</u> affect another of the set of tertiary scan parameters, but not affect any of the set of secondary scan parameters and any of the set of primary scan parameters. Such is not called for in claim 9. Instead, claim 9 calls for a change to one of the set of tertiary scan parameters <u>to be allowed to</u> affect another of the set of tertiary scan parameters, but not affect any of the set of secondary scan parameters and any of the set of primary scan parameters. There is no support for construing "may" as used in claim 9 to include that a change to one of the set of tertiary scan parameters <u>is allowed to or is not allowed to</u> affect another of the set of tertiary scan parameters. Such construing is not called for in claim 9 and is improper.

The Examiner further stated that "[a]s shown in the previous office action the tertiary parameters [of the prior art] cannot directly be changed and therefore changes to one parameter cannot affect another set of tertiary parameters." *Advisory Action, August 25, 2005.* Applicant agrees with the Examiner. Since the Examiner concluded that the prior art teaches that changes to one parameter <u>cannot</u> affect another set of tertiary parameters, a change to a tertiary parameter <u>is not allowed</u> to affect another of the set of tertiary parameters. As stated above, such is contrary to that called for in claim 9. That is, while the prior art does not allow a change to a tertiary

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parameter to affect another tertiary parameter, claim 9 does allow a change to a tertiary parameter to affect another tertiary parameter.

Since claim 9 allows a change to one tertiary parameter to affect another of the set of tertiary parameters and since the prior art does not allow a change to one tertiary parameter to affect another of the set of tertiary parameters, the prior art fails to teach each and every element of the claim, and claim 9 is not anticipated by the prior art of record. Accordingly, Applicant respectfully requests pre-appeal review of the rejection of claim 9, and all claims depending therefrom.

With regard to claim 1, claim 1 calls for determining a state of validity of a number of remaining scan parameters and notifying a user of if any state of validity is out of a predefined range for the scan parameter input before updating the number of remaining scan parameters. The Examiner stated that "Wu however does not disclose alerting the user that the state of validity is out of range for any of the parameters before updating the remaining scan parameters." *Final Office Action, June 7, 2005, p. 6.* The Examiner stated that "Gaertner discloses (col. 7, lines 25-32) that the user is alerted that the state of validity is out of range when one parameter is changed." *Id.*

Gaertner discloses setting parameter ranges that "may be used as part of a monitoring program which would then take actions based on satisfying these ranges, e.g., alerting users that these parameter ranges were satisfied." *Gaertner, col. 7, lines 5-24.* Gaertner discloses a state machine in Fig. 7 that determines whether conditions are met. *See Id.* The home state of the state machine is the initial state and remains the current state "[a]s long as 'D' is not in the range. . . ." *Id.* If "D" enters the specified range, then the current state of the state machine moves to the monitor state. *See Id.* Once in the monitoring state, "[i]f 'D' exits the range before the allotted time interval has been satisfied, state machine returns along path 405 to the home state 400." *Id.* If both "D" and "I" are satisfied "the state machine returns to home state along path 407, where the threshold structure and the values of 'T' and 'D' are sent to the monitoring module and the timer is stopped." *Id.* Gaertner teaches that "[o]nce the state machine determines that the range is satisfied, the monitoring program handles the determination of the actual alarms based on the relationships which the range may have with other ranges." *Gaertner, col. 7, lines 25-32.* If an "and" relationship exists between a first and a second range, "the monitoring program would look to a second state machine to determine whether the range conditions of a second set of parameters were satisfied before alerting users or taking other actions." *Id.*

Thus, Gaertner teaches that a first parameter, "D", is monitored after satisfying a first range, and a second parameter, "T", is monitored as long as "D" remains within the range. If "D"

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exits the range before "T" is satisfied, the current state of the state machine returns to the home state. Gaertner does not teach or suggest that the monitoring program receives the threshold structure and the values of "T" and "D" upon a return to the home state before "T" is satisfied. Rather, Gaertner only teaches that the monitoring program receives the threshold structure and the values of "T" and "D" "if 'D' stays within the range and time 'T' is satisfied. . . ." *Gaertner, col. 7, lines 5-24.* Therefore, once "D" and "T" are determined to be satisfied, the monitoring program receives their values and the threshold structure.

For the monitoring program to receive the values of "D" and "T", the ranges set for each must be satisfied. That is, "D" must have a valid range value for the duration of "T" for the monitoring program to receive their values. Therefore, if "D" has a valid range when the monitoring program receives its value, "D" is not out of a predefined range. In fact, "D" is within a predefined range. Such is contrary to that called for in claim 1. Claim 1 calls for notifying a user of if any state of validity is out of a predefined range for the scan parameter input before updating the number of remaining scan parameters. Gaertner fails to teach sending the value of "D" to the monitoring program if "D" exits the range before "T" is satisfied. Therefore, since the monitoring program does not receive an input that "D" is out of a predefined range, an alarm controlled by the monitoring program cannot be activated, and a user is not notified.

Furthermore, even if the monitoring program was to receive an indication that "D" had exited the range before "T" was satisfied, there is no teaching or suggestion that the state machine in Gaertner monitors the value of "D" before "D" is updated. That is, it would be obvious to one skilled in the art that when the state machine determines that "D" is within or not within the specified range, "D" has already been updated to its current value. Since the updated value of "D" is monitored by the state machine, Gaertner does not teach notifying a user if any state of validity is out of a predefined range for the scan parameter input before updating the number of remaining scan parameters.

Accordingly, Applicant respectfully believes that the rejection of claim 1 and all claims depending therefrom to be improper and requests pre-appeal review thereof.

With regard to claims 19 and 25, the Examiner repeated the statement that "Wu however does not disclose alerting the user that the state of validity is out of range for any of the parameters before updating the remaining scan parameters" *Final Office Action, supra at p. 6.* The Examiner similarly repeated the statement that "Gaertner discloses (col. 7, lines 25-32) that the user is alerted that the state of validity is out of range when one parameter is changed." *Id.*

Claim 19 calls for displaying an indication of the at least one effect on the GUI prior to modification of the another scan parameter. Claim 25 calls for displaying on the console if there

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is any consequence of modifying the at least one of the plurality of options on another option before modifying the another option. Applicant incorporates the remarks set forth above with regard to claim 1. As indicated above, Gaertner does not teach displaying an indication of the at least one effect on the GUI prior to modification of the another scan parameter or displaying on the console if there is any consequence of modifying the at least one of the plurality of options on another option before modifying the another option. Gaertner teaches a monitoring program that receives the values of two parameters, "D" and "T", after the ranges set therefor are satisfied. The monitoring program further receives the values of "D" and "T" after they have been modified. There is no teaching or suggestion in Gaertner that "D" and "T" are unmodified before sending their values to the monitoring program.

The prior art fails to teach or suggest displaying an indication of the at least one effect on the GUI <u>prior to modification</u> of the another scan parameter or displaying on the console if there is any consequence of modifying the at least one of the plurality of options on another option <u>before modifying</u> the another option as called for in claims 19 and 25, respectively. Accordingly, Applicant respectfully believes that the rejection of claims 19, 25, and all claims depending therefrom cannot be sustained and, therefore, and requests pre-appeal review thereof.

Therefore, in light of at least the foregoing, Applicant respectfully believes that all claims of the present application are patentable over the art of record. As a result, Applicant respectfully requests reversal of the Examiner's rejections and timely issuance of a Notice of Allowance for claims 1-9, 11, and 13-31.

Applicant appreciates the panel's review and cordially invites the panel members to call the undersigned, should they consider any matters unresolved.

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Respectfully submitted,

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